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APPLICATION NO	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/019,262	03/14/2002	Mie Takahashi	2001-1890A	1310

513 7590 06/05/2003

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EXAMINER
THERKORN, ERNEST G

ART UNIT	PAPER NUMBER
1723	6

DATE MAILED: 06/05/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

mc-6

Office Action Summary

Application No.	Applicant(s)
10/013,262	TAKAHASHI
Examiner	**Art Unit**
THIERMORN	1723

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) [X] Responsive to communication(s) filed on Dec 28, 2001.

2a) [ ] This action is **FINAL**. 2b) [X] This action is non-final.

3) [ ] Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) [X] Claim(s) 1-17 is/are pending in the application.

4a) Of the above, claim(s) _____ is/are withdrawn from consideration.

5) [ ] Claim(s) _____ is/are allowed.

6) [X] Claim(s) 1-17 is/are rejected.

7) [ ] Claim(s) _____ is/are objected to.

8) [ ] Claims _____ are subject to restriction and/or election requirement.

Application Papers

9) [ ] The specification is objected to by the Examiner.

10) [ ] The drawing(s) filed on _____ is/are a) [ ] accepted or b) [ ] objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) [ ] The proposed drawing correction filed on _____ is: a) [ ] approved b) [ ] disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) [ ] The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) [ ] Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) [ ] All b) [ ] Some* c) [ ] None of:

1. [ ] Certified copies of the priority documents have been received.
2. [ ] Certified copies of the priority documents have been received in Application No. _____.
3. [ ] Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) [ ] Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

a) [ ] The translation of the foreign language provisional application has been received.

15) [ ] Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) [X] Notice of References Cited (PTO-892)
2) [ ] Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) [ ] Information Disclosure Statement(s) (PTO-1449) Paper No(s).
4) [ ] Interview Summary (PTO-413) Paper No(s).
5) [ ] Notice of Informal Patent Application (PTO-152)
6) [ ] Other:

Claims 1-17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The metes and bounds of "chromatographic specimen" can not be determined. The term does not appear to be defined in the specification. The ordinary meaning of the term would be a sample that was chromatographed. However, the context of the claim would not appear to indicate that this was the intended meaning. As such, the term is considered to render the claims indefinite. Pages 4-18 of the specification improperly refer to specific claims. This is considered to render the claims indefinite and the specification is required to be amended to remove references to the claims. Claim 13's "such as" is considered to render the claim indefinite. Claim 14 is considered to contradict claim 12, rendering both claims indefinite.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground

provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-17 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-29 of U.S. Patent No. 6,497,842. Although the conflicting claims are not identical, they are not patentably distinct from each other because they differ only in an obvious difference in scope.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless -
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over that which is conceded to be old on pages 1-4 of the specification in view of each of Nakaya (Japan Patent No. 11-044689), Mochizuki (Japan Patent No. 10-332,700), and Takahashi (Japan Patent No. 11-094,817). At best, the claims differ from that which is conceded to be old on pages 1-4 of the specification in reciting use of a liquid impermeable sheet. Nakaya (Japan Patent No. 11-044689) (Abstract) discloses a laminate protects the chromatographic strip. Mochizuki (Japan Patent No. 10-332,700) (Abstract) discloses a moisture impermeable film allows the chromatographic test strip to be carried, handled, kept, and preserved after reaction. Takahashi (Japan Patent No. 11-094,817) (Abstract) discloses that a moistureproof sheet allows the test strip to be preserved for a long time. It would have been obvious to use a liquid impermeable sheet either because Nakaya (Japan Patent No. 11-044689) (Abstract) discloses a laminate protects the chromatographic strip, or because Mochizuki (Japan Patent No. 10-332,700) (Abstract) discloses a moisture impermeable film allows the chromatographic test strip to be carried, handled, kept, and preserved after reaction, or because Takahashi (Japan Patent No. 11-094,817) (Abstract) discloses that a moistureproof sheet allows the test strip to be preserved for a long time.

Claims 1-17 are rejected under 35 U.S.C. 102(B) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over each of Nakaya (Japan Patent No. 11-044689), Mochizuki (Japan Patent No. 10-332,700), and Takahashi (Japan Patent No. 11-094,817). The claims are considered read on each of Nakaya (Japan Patent No. 11-044689), Mochizuki (Japan Patent No. 10-332,700), and Takahashi (Japan Patent No. 11-094,817). However, if a difference

exists between the claims and each of Nakaya (Japan Patent No. 11-044689), Mochizuki (Japan Patent No. 10-332,700), and Takahashi (Japan Patent No. 11-094,817), it would reside in optimizing the elements of each of Nakaya (Japan Patent No. 11-044689), Mochizuki (Japan Patent No. 10-332,700), and Takahashi (Japan Patent No. 11-094,817). It would have been obvious to optimize the elements of each of Nakaya (Japan Patent No. 11-044689), Mochizuki (Japan Patent No. 10-332,700), and Takahashi (Japan Patent No. 11-094,817) to enhance separation.

Any inquiry concerning this communication should be directed to E. Therkorn at telephone number (703) 308-0362.

Ernest G. Therkorn
Primary Examiner
Art Unit 1723

EGT/12
June 2, 2003